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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuki SASAKI et al.

Group Art Unit: 1617

Application No.: 10/015,611

Examiner: G. MITCHELL

Filed: December 17, 2001

Docket No.: 111482

For: RESIN POWDER FOR DERMATOLOGIC COMPOSITION, SKIN CLEANSING  
AGENT AND COSMETIC COMPOSITION USING THE POWDER, AND  
PREPARATION PROCESS OF THE POWDER

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the November 30, 2005 Office Action, reconsideration of the rejections are respectfully requested in light of the following remarks.

Claims 1-22 are pending in this application. Claims 18-22 are currently withdrawn.

**I. Rejection Under 35 U.S.C. §102(b)**

Claims 1, 2, 4, 6-10 and 12-14 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,080,519 ("Ishiyama"). This rejection is respectfully traversed.

Claim 1 recites a resin powder comprising resin particles consisting essentially of a resin having an average volume particle size of 2.0 to 20.0  $\mu\text{m}$ , a shape factor SF1 of 110 to 140 and an average volume particle size distribution GSDv of 1.3 or less.

Ishiyama teaches toner compositions comprising a coloring agent and a binder resin having a volume average particle size of 2 to 9 micrometers, a shape factor SF1 of 110 to

140, and an average volume particle size distribution GSDv of 1.30 or less. See Ishiyama, column 3, line 66 to column 4, line 12.

In contrast to the resin powder recited in claim 1, Ishiyama does not disclose a resin powder comprising resin particles consisting essentially of a resin. Rather, Ishiyama discloses a method of producing toner resin particles by preparing a resin particle dispersion and mixing it with a coloring agent dispersion and a releasing agent dispersion to form aggregated particles. The aggregated particles are then heated in order to fuse and unite the particles. See Ishiyama, column 8, lines 16-29. Thus, Ishiyama's toner composition requires a coloring agent and a binder resin. In addition, Ishiyama teaches that the coloring agent dispersion and the releasing agent dispersion are aggregated with the resin particle dispersion in order to form resin particles, and thus that the coloring agent is essential to the toner composition of Ishiyama. As a result, Ishiyama does not teach or suggest resin particles consisting essentially of a resin.

In the Final Rejection, the Patent Office alleged that the burden was on Applicants to establish that "consisting essentially of" in the present claims excluded the coloring agent required in Ishiyama. Specifically, the Patent Office alleged that it had not been shown that the coloring agent in Ishiyama affects the basic and novel characteristics of the present resin powder for a dermatologic composition. Applicants respectfully disagree.

As was demonstrated in the Declaration Under 37 C.F.R. §1.132 by Hirotaoka Matsuoka ("Declaration") filed with a prior Amendment on March 16, 2005, when resin particles containing colorants are produced, the colorants tend to aggregate and adhere to the surface of the resin particles. These precipitated colorants can become dislodged from the surface of the resin particles during processing, such as cosmetic production, due to the colorants and resins have different hardness values. The hardness and shape of the dislodged

colorant adversely affects the affinity to the skin, spreadability and smoothness of the resin particles and of the finished product, as shown on page 5, paragraphs 2-4 of the Declaration.

Affinity to the skin, spreadability and smoothness are plainly basic and novel characteristics required of a resin powder for a dermatologic composition as claimed. A resin powder not having suitable values for these properties would not be suitable in a dermatologic composition as claimed.

Thus, the evidence shows that the presence of a coloring agent affects the basic and novel characteristics of the resin powder. As such, the coloring agent as taught by Ishiyama is excluded by the recitation "consisting essentially of" as recited in claim 1.

For the foregoing reasons, Applicants respectfully submit that Ishiyama fails to anticipate the subject matter of claim 1, and claims dependent therefrom.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

## **II. Rejection Under 35 U.S.C. §103(a)**

Claims 3, 5, 11 and 15-17 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Ishiyama as applied to claims 1, 2, 4, 6-10 and 12-14 above, and further in view of U.S. Patent No. 5,976,750 ("Hagi"). This rejection is respectfully traversed.

Hagi also teaches toner particles that include a colorant and a binder resin, which has a volume average particle size of 3 to 7 micrometers and a shape factor SF1 of 100 to 130. See Hagi, Abstract; column 3, lines 9-25; and column 4, lines 6-12. Specifically, Hagi teaches incorporating colorants into binder resin during polymerization to form toner particles. See Hagi, column 7, line 53 to column 8, line 11.

As discussed extensively above, Ishiyama fails to teach or suggest a resin powder comprising resin particles consisting essentially of a resin as claimed. The Patent Office relied on Hagi as allegedly teaching the specific GSDp, specific molecular weight, specific

acid value range, or additional fine particles adhered to the resin particles. However, even if Ishiyama were to have been combined with Hagi as alleged by the Patent Office, the presently claimed subject matter still would not have been achieved because Hagi does not remedy the deficiencies of Ishiyama. Specifically, Hagi also does not teach or suggest a resin powder comprising resin particles consisting essentially of a resin as recited in claim 1. Hagi, like Ishiyama, requires a colorant in the toner particles.

For the foregoing reasons, Applicants respectfully submit that Ishiyama and Hagi, alone or in combination, would not have led one of ordinary skill in the art to claims 3, 5, 11 and 15-17.

Reconsideration and withdrawal of this rejection are respectfully requested.

**III. Rejoinder**

Applicants submit that upon allowance of claims 1-17, composition claims 18-22 should be rejoined with the application and similarly allowed.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: February 28, 2006

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